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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,943	01/29/2004	Yasuyuki Numajiri	00862.023438.	1830

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FITZPATRICK CELLA HARPER & SCINTO  
30 ROCKEFELLER PLAZA  
NEW YORK, NY 10112

EXAMINER
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SHAW, AMANDA MARIE

ART UNIT	PAPER NUMBER
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1634

MAIL DATE	DELIVERY MODE
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05/11/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b>	<b>Application No.</b> 10/765,943	<b>Applicant(s)</b> NUMAJIRI, YASUYUKI	
	<b>Examiner</b> Amanda Shaw	<b>Art Unit</b> 1634	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 29 April 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☒ They raise the issue of new matter (see NOTE below);
- (c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: none.
- Claim(s) objected to: none.
- Claim(s) rejected: 28-33.
- Claim(s) withdrawn from consideration: none.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_
13. ☐ Other: \_\_\_\_\_.

/Carla Myers/  
 Primary Examiner, Art Unit 1634

Continuation of 3. NOTE: The proposed amendments to claims 32 and 33 raise the issues of new matter. In the instant case the specification does not appear to provide support for the amendment which recites "generating test information ONLY if a comparison result of the comparison step indicates that the first identification information and the second identification information match". The applicants response says that support for this amendment can be found throughout the specification, for example, in the first to third embodiments as well as Figures 1-3, however the applicants have not pointed to specific page and line numbers where support can be found. After reviewing the first to third embodiments of the specification and Figures 1-3 the disclosure does not appear to provide specific support for this amendment. Further the proposed amendments to claims 32 and 33 raise new issues because the scope of the claims has changed. Previously the claims encompassed a step of "outputting the test information to a storage medium". However now the claims encompass a step of "outputting the test information so that the test information is stored on a computer readable storage medium. Since the claims did not previously require a computer readable storage medium the applicants amendments would necessitate a new search aimed at identifying the prior art most relevant to the claims as amended and consideration of that prior art with regard to whether it renders obvious the claimed invention. Thus the proposed amendments do not place the application in better form for appeal by materially reducing or simplifying the issues for appeal.

Continuation of 11. does NOT place the application in condition for allowance because: With regard to the rejection made under 35 USC 101 the applicants arguments pertain to the claims as amended. These arguments are considered moot in view of the non entry of the after final amendment however it is noted that if the amendment had been entered the 101 rejections would have been withdrawn.

Regarding the art rejections the applicants arguments pertain both to the pending claims and the amended claims. Specifically the Applicants argue that Kris fails to disclose or suggest a DNA microarray including areas with different probe groups. This argument has been fully considered but is not persuasive. Kris teaches a surface comprising a plurality of spatially discrete regions which can be termed test regions and which can be wells, at least two of which are substantially identical (Col 1, lines 55-60). In the instant case the regions of Kris are being interpreted as having different probe groups because "substantially identical" does not mean that they are 100% identical. Further it is noted that the primary references (Hogan, Barrett, and Hashmi) all teach probes for personal identification and probes for disease detection (which would be considered as different probe groups). Kris is only being relied upon to teach that microarrays can have multiple spatially discrete regions of probes. The Applicants next argument is that as the amended the claims explicitly state that the analysis is performed only when the identification information matches. This argument is considered moot in view of the non entry of the after final amendment however it is noted that if the amendment had been entered the claims still would not be limited to a method where the analysis is performed only when the identification information matches. Instead the generation step would be interpreted as a step of analyzing a hybridization state of each DNA probe obtained from the second DNA probe group (regardless if the identification information matches) BUT only "generating test information" if the identification information matches. Here "analyzing a hybridization pattern" is not equivalent to "generating test information" and the term "only" seems to only apply the step of "generating test information".